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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,481	06/04/2001	Eimar M. Boesjes	BOESJES4	5356
23892	7590	02/11/2005	EXAMINER	
DAVID S ALAVI 3762 WEST 11TH AVENUE #408 EUGENE, OR 97402			O CONNOR, GERALD J	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/874,481

Applicant(s) ✓

Boesjes

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on October 18, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 1-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on June 4, 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of Invention II (Claims 23-44) in the reply filed October 18, 2004 is hereby acknowledged. The traversal is on the ground(s) that the restriction is improper because the recited method could *not* be performed by hand as was suggested by the examiner when making the restriction, since steps are performed by a programmed processor.
2. Applicant's arguments have been fully considered but are not found persuasive.
3. Regarding the argument that the recited method could *not* be performed by hand, since steps are performed by a "programmed processor," a programmed processor need not be a computer CPU under control of a computer program. A "programmed processor," as the claims merely broadly recite, could, in fact, indeed be a person (the person who does the processing). Of course, a programmed processor could be a computer CPU. It just is not required to be, as recited.
4. The restriction requirement is still deemed proper and is therefore made FINAL.
5. Claims 1-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction requirement in the reply filed October 18, 2004.

Claim Rejections - 35 USC § 101

6. The following is a quotation of 35 U.S.C. 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 23-44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 23-44 are drawn to a method of producing a disembodied data structure. It has been held that such claims are considered to comprise non-statutory subject matter, for merely manipulating an abstract idea without producing any “useful, concrete, and tangible result.” *In re Warmerdam*, 33 F.3d 1354; 31 USPQ2d 1754 (Fed. Cir. 1994).

Additionally, method claims that fail to *require* the use of any technology, such as claims 23-44, are considered non-statutory under § 101, for failing to fall within the technological arts. Claims must be tied to a technological art. To overcome this aspect of the rejection, a positive limitation in the body of the claim is required to recite the use of some technology, such as either a computer, *per se*, or else some other computer element that would inherently and necessarily require a computer (e.g., a website), or else some other aspect or element of technology.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 23-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sharp et al. (US 6,263,317).

Sharp et al. disclose a multiply-integrated method of product inventory, sales, and distribution, comprising: receiving product identifying information, pricing information, and product inventory information from multiple participating product suppliers and entering the information into a supplier database, wherein the multiple suppliers may include any of manufacturers, distributors, and retailers, and the suppliers offer products of a common category, receiving order information and storing it in a database, wherein the orders may be placed by multiple purchasers, wherein the multiple purchasers may include any of manufacturers, distributors, retailers, and retail purchasers, attempting to locate an available product for each ordered product, issuing instructions for delivery for each ordered product, updating inventory information, and creating a financial accounting record for each order, but the method of Sharp et al. does not explicitly disclose maintaining an order history by keeping a database of orders that have been fulfilled. However, maintaining an order history by keeping a database of orders that have been fulfilled is a well known, hence obvious, step to follow in an electronic

commerce system. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Sharp et al. to maintain an order history by keeping a database of orders that have been fulfilled, as is well known to do, in order to allow purchasers to conveniently find/review what they had ordered previously so that they could reorder the same item, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claims 25-30, Sharp et al. fail to disclose that the purchaser has any particular relationship to any other entity associated with the product (i.e., a retailer of the product purchasing the product from another retailer of the product). However, the method of Sharp et al. does not preclude that one entity associated with the product could purchase the product from another entity associated with the product, and one of ordinary skill in the art would recognize that such a step could be performed using the method of Sharp et al. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have used the method of Sharp et al. to allow any given entity associated with a particular product to purchase that product from any other entity associated with that same product, in order to allow an entity that needed the product right away to obtain it even when their traditional source was unable to provide it right away, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claims 35-37, the method of Sharp et al. fails to disclose auctions/bidding, instead relying on traditional catalog fixed-price sales. However, auctions/bidding and fixed-price sales are considered art-recognized equivalents for determining/setting a sales price for an item being sold. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Sharp et al. by making a substitution of art-recognized equivalents by setting prices as the result of bidding rather than setting a fixed-price, merely as a matter of design choice, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claims 38-40, the method of Sharp et al. fails to include aggregating orders. However, aggregating orders is a well known, hence obvious, step to perform in any method of electronic ordering. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Sharp et al. so as to allow aggregating of orders, as is well known to do, in order to allow purchasers to increase their purchasing power by pooling their orders, and since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claims 42-44, the method of Sharp et al. fails to explicitly disclose that the method is used for selling products, wherein the products include used, rare, collectible, private-label, or out-of-production products. However, selling such products is well known, hence obvious, when performing such a method of electronic commerce. Therefore, it would have

been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Sharp et al. so as to use it to sell any or all of used, rare, collectible, private-label, or out-of-production products, in order to use the method for as broad a range of products as possible, and since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to the disclosure.

11. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(703) 305-1525**, and whose facsimile number is **(703) 746-3976**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

Inquiries of a general nature or simply relating to the status of the application should be directed to the receptionist, whose telephone number is **(703) 308-1113**.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at **(703) 308-5183**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306** (fax-back auto-reply receipt service provided). Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be left with the receptionist on the seventh floor of Crystal Park Five, 2451 Crystal Dr, Arlington, VA 22202.

GJOC

December 23, 2004

 (12-23-04)

Gerald J. O'Connor

Patent Examiner

Group Art Unit 3627